

REMARKS

1. In response to the Office Action mailed June 16, 2005, Applicant respectfully requests reconsideration. Claims 20-50 were last presented in this application. In the outstanding Office Action, claims 36, 45 and 46 were rejected; claims 37-40, 47 and 48 were objected to; and claims 20-35, 41-44, 49 and 50 were withdrawn from consideration. By the foregoing Amendments, claims 38, 39, 46 and 47 have been amended. Claims 20-35, 41-44 and 49-50 have been canceled. No claims have been added. Thus, upon entry of this paper, claims 36-40 and 45-48 will be pending in this application. Of these nine (9) claims, two (2) claims (claims 36 and 45) are independent. These Amendments are believed not to introduce new matter and their entry is respectfully requested.

Art of Record

2. Applicant acknowledges receipt of form PTO-892 identifying additional references made of record by the Examiner.

Election/Restrictions

3. This application was restricted to one of the following inventions under 35 U.S.C. § 121: Group I including claims 20-28, drawn to a coiled spring battery contact (classified in class 429, subclass 181); Group II including claims 29-35 and 41-44, drawn to a battery powered device (classified in class 429, subclass 170); Group III including claims 36-40 and 45-48 drawn to a battery powered device (classified in class 429, subclass 171); and Group IV including claims 49-50, drawn to a method for minimizing battery-to-device contact resistance (classified in class 429, subclass 157).

4. Applicant affirms that on April 6, 2005, Applicant elected without traverse to prosecute the invention of a battery powered device (claims 36-40 and 45-48). Claims 20-35, 41-44 and 49-50 have been cancelled without prejudice or disclaimer by the foregoing Amendments. Applicant reserves the right to pursue the subject matter of the withdrawn claims in a continuation/divisional application.

Allowable Subject Matter

5. Applicant notes with appreciation the Examiner's indication that claims 37-40 and 47-48 would be allowable if rewritten in independent form including all of the limitations of their respective base claim and any intervening claims.

Claim Amendments

6. Minor amendments have been made to the claims. These amendments have not been made in response to any rejection or to distinguish the claimed invention from prior art. Nor do these amendments narrow the claims in any way. No new matter has been added.

Claim Rejections

7. Independent claims 36 and 45 and dependent claim 46 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,896,875 to W.E. Reed, *et al.* (hereinafter, "Reed"). Based upon the above Amendments and following Remarks, Applicant respectfully requests reconsideration and withdrawal of these rejections.

8. The Reed device is a motor driven fishing reel that relies on one or more batteries within the device to power the motor. (*See*, Reed, col. 1, lns. 15-19.) The batteries 22 are maintained in place by, among other things, a coiled spring 18 that has a contact 20 at its narrow end, and which is secured to the casing 10 at its wide end. (*See*, Reed, col. 2, lns. 8-13; Fig. 1.) The Examiner has asserted that the limitation of Applicant's claim 36 "to scrape away a portion of an insulating contaminant layer from a surface of an abutting terminal of an installed battery" is an inherent characteristic of the Reed spring 18 because coiled spring 18 "is capable of performing said function." (*See*, Office Action, pg. 4, para. 2.) Applicant respectfully disagrees.

9. Reed fails to meet the requirement articulated in the MPEP that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill...'" (*See*, MPEP 2112, citing *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (*See*, MPEP 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).)

10. The Reed coiled spring contact 20 does not *necessarily* perform Applicant's claimed function as recited in, for example, independent claims 36 and 45. The Reed contact plate 20 is neither described structurally nor functionally. In fact, there is no teaching regarding the shape of the contact plate 20 other than the portrayal in Figure 1 of Reed that the contact has some thickness, and references throughout the Reed specification that contact plate 20 is a "plate." Nor is there any disclosure regarding spring 18 other than it is a coiled spring attached to the battery case as noted, and that it compresses when a battery cell 22 is installed. (*See*, Reed, col. 2, lns. 64–68; col. 4, ln. 65; Fig. 1.)

11. Accordingly, the only inherent operation which can be derived from the Reed specification is that contact plate 20 is capable of performing the purpose intended by Reed; that is, to provide adequate surface contact area so that an electrical connection may be established with an installed battery cell 22. In addition, because Reed is concerned only with maintaining the batteries in place, the amount of pressure applied by the spring 18 would only need to be sufficient to maintain a completed circuit. For example, there is no express, implicit or inherent disclosure in Reed regarding a feature or characteristic of coiled spring 18 and contact plate 20 that suggests that a relative lateral movement between an appropriately-configured contact plate 20 and a terminal of an installed battery cell 22 occurs as the battery cell is placed into the casing, that a pressure sufficient to rupture a contaminate layer is imparted by an appropriately-configured contact plate 20, etc.

12. For at least the above reasons, Applicant respectfully asserts that there is no express, implicit or inherent disclosure in Reed indicating that the Reed device performs the alleged function recited in Applicant's claims 36 and 45. Applicant therefore respectfully asserts that the Section 102 rejection of independent claims 36 and 45, and dependent 46, are improper and should be withdrawn.

13. Should the examiner continue to rely on allegedly inherent features of Reed in a future rejection, Applicant requests that the examiner satisfy the requirements clearly set out in the MPEP: "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (*See*, MPEP 2112, citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).)

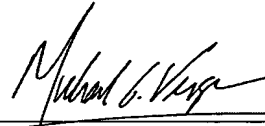
Dependent Claims

14. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them a fortiori and independently patentable over the art of record. Accordingly, Applicant respectfully requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

15. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Michael G. Verga", is written over a horizontal line.

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